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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,310	05/07/2007	Terry O'Halloran	PA1645.ap.US	9252

7590 09/30/2010  
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EXAMINER
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CHAN, ALLEN

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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09/30/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/591,310		O'HALLORAN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	ALLEN CHAN		3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/14/07</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 2 and 10, the claims recite “wherein the probability of winning the jackpot based upon the scatter symbols is linearly dependent upon the size of the player’s wager”. The examiner sees no support in the specification for this limitation. While the specification discusses the probability of a scatter symbol being in an active state is dependent on the size of the player's wager (see pg. 4, 2nd paragraph), the specification is silent with regards to the probability of winning a jackpot being dependent on the size of the player's wager.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2 and 10, the claims recite "wherein the probability of winning the jackpot...is linearly dependent upon the size of the player's wager". However, parent claims 1 and 9 recite a limitation where the size of the player's wager affects the probability of a variable state scatter symbol being active. Thus, it is unclear whether the size of the player's wager affects the variable state scatter symbol or the probability of winning the jackpot or both. In addition, both claims recite the limitation "wherein the probability of winning the jackpot based upon the scatter symbols". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a computer software product, which is a computer program *per se*, which is non-statutory subject matter. The examiner suggests that the claim be amended to recite "a non-transitory computer readable medium containing a computer software product, adapted to implement the method of claim 1".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 2003/0236116 A1) in view of Ward (US Provisional Application 60/454,822, filed 3/13/2003, as shown by US 2004/0180714 A1).

Regarding claims 1 and 9, Marks et al. discloses a method of providing a jackpot in a gaming machine, said machine having multiple simulated reels, and at least one pay line, including at least the steps of determining a player's wager (see par. [0006]), playing the game, so that the simulated reels assume a specific configuration showing symbols across said reels, wherein one or more of said symbols can be a scatter symbol (see figs. 1A-1C and par. [0068]), and determining if scatter symbols appear across said reels in a predefined manner, and if so then paying said jackpot (see par. [0069]). However, Marks et al. does not explicitly disclose that the scatter symbols can be a variable state scatter symbol, the variable states being an active and an inactive state and wherein the probability of a variable state scatter symbol is dependent upon the size of the player's wager. Ward discloses a game where the paylines can be active or inactive and where the variable state of the paylines is dependent on the size of the player's wager (see par. [0061]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the concept of a variable state symbol/payline dependent on a wager amount as taught by Ward to the game and scatter symbol of Marks et al. in order to allow the player to increase the probability of winning by wagering a higher amount.

Regarding claims 2 and 10, Ward discloses that the paylines are activated based on a linear relationship with the player's wager amount (i.e. each multiple of the base bet activates another payline) (see par. [0061]).

Regarding claims 3 and 11, Marks et al. discloses scatter and wild symbols for a game (see par. [0068]-[0070]). It is obvious that these symbols can be used in any manner in a game, at the discretion of the casino operator.

Regarding claims 4 and 12, Ward discloses that the variable state of the paylines is dependent on the size of the player's wager relative to a maximum possible wager (see par. [0061]).

Regarding claims 5 and 6, Marks et al. discloses that the jackpot can be accumulated across a plurality of linked machines or on a single machine (see par. [0011]).

Regarding claims 7 and 14, the limitations of the claim have been discussed above with regards to claims 1 and 4 (for claim 7) and claims 9 and 12 (for claim 14).

Regarding claims 8 and 13, Ward discloses a plurality of gaming machines linked to a central jackpot controller (see par. [0096]). Marks et al. also discloses providing a progressive jackpot which is incremented from wagers on a plurality of machines (see par. [0011]).

Regarding claim 15, Ward discloses a computer program executed by the processor (see par. [0032]).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yoseloff (US 6,159,096) discloses a method and apparatus for configuring a slot-type wagering game.

Kaminkow (US 2004/0002373 A1) discloses a gaming device having a multiple moving object game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALLEN CHAN whose telephone number is (571)270-5529. The examiner can normally be reached on Monday through Thursday 9:00 AM to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALLEN CHAN/  
Examiner, Art Unit 3714  
9/28/2010

/John M Hotaling II/  
Primary Examiner, Art Unit 3714